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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,999	12/14/2001	John R. Klug	5814.05	4368

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DORSEY & WHITNEY, LLP
INTELLECTUAL PROPERTY DEPARTMENT
370 SEVENTEENTH STREET
SUITE 4700
DENVER, CO 80202-5647

EXAMINER

CHOULES, JACK M

ART UNIT	PAPER NUMBER
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2167

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/021,999

Applicant(s)

KLUG, JOHN R.

Examiner

Jack M. Choules

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3 IDS's 3 pages</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-31 remain in the application and are again presented for examination claims 1-14 and 21 having been amended.

Information Disclosure Statement

2. The information disclosure statements (IDS's) received by the office on (1) 6 October 2004, (2) 24 January 2005, and (3) 23 March 2005 for this application. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, these information disclosure statements have been considered by the examiner. An initialed Copy should be attached to this action. Examiner notes that all documents submitted in these 3 IDS's are actions and filings in copending applications, while 37 CFR 1.97 does not specifically prohibit this use of IDS's applicant is advised that all 4 applications are in the IFW image system all filed papers are available to the examiners and to anyone with rights to access these applications it is not considered necessary to resubmit all prosecution papers from all copending applications as IDS's. If applicant desires it would be helpful if a note detailing the progress in the concurrent applications were inserted in each office action. As an example:

Prosecution of copending applications

In Re-exam application 90/006,940 for Patent No. 5,799, 320 a supplemental response was sent on March 15, 2005, which included a second declaration by Gary J. Nutt ...

This information will notify the examiner that relevant information may be found in the copending file without the time and expense filing and responding to IDS's. This examiner

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would even be willing to not in the next paper that such information had been reviewed if requested. Unless relevant articles, publications, and patents and other such documents from outside sources are found which are relevant and to the prosecution and these should be submitted on formal IDS's according to regulation cited above. Further a declaration or other paper will be relied on in arguments it probably should be filed as such, rather than on an IDS, in each application it is used in.

Terminal Disclaimer

3. The terminal disclaimer filed on 03/29/2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US patent Nos. 4,799,320 and 6,411,965 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Arguments

4. Applicant's arguments filed 29 March 2005 have been fully considered but they are not persuasive. The applicant argues as follows:

a. That "as set forth in Dr. Nutt's Declarations, Sarin does not teach, disclose mention or suggest to one of ordinary skill in the art, by and before 23 August 1989, apparatus which utilize a processor in a personal computer to provide an update for a file to two or more user devices substantially contemporaneously with the execution of an edit for the file."

5. The examiner respectfully disagrees as follows,

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a. Dr. Nutt gives two declarations both are in this file together as an affidavit filed 29 March 2005 the first declaration states that at the time of the priority date, 23 August 1989, of the current application one of ordinary skill in the art would understand a personal computer (PC) as being “a stand-alone device which included a central processing unit (CPU) and did not need to be connected to a network or any other computer to operate or execute an application program.” While one of ordinary skill in the art workstations differed “from PC in that workstations did not require BIOS firmware” and a PC generally did (see paragraphs 8 and 9 on page 2 of the [first] declaration of Gary J. Nutt). In the Second declaration states prior to 23 August 1989, “one of skill in the art would have understood a personal computer or “PC” to be a computer whose hardware architecture complied with the IBM Personal Computer architecture.” The disclosure further states that WINDOWS 386 would be used, as it was the current Microsoft WINDOWS application (see paragraph 7 on page 2 of the second declaration of Gary J. Nutt). And all the conclusions as to obviousness and utility of the PC use in the current invention were made based on an IBM PC running WINDOWS 386 (predecessor to windows 3.0). Although the arguments are persuasive based on the IBM PC running WINDOWS 386 it is quickly noticed that this is a much narrower definition of a PC than the definition of PC in the first declaration, further the examiner finds in the **Dictionary of Computers, Information Processing and Telecommunication 2nd Edition** (1987) a definition with a further distinct scope personal computer (PC): a relatively inexpensive, general-use computer created for a single user in an office or home. And for a workstation (WS) (1) a configuration of

input-output equipment at which an operator works. (D) (2) a station at which an individual can send data to or receive data from a computer for the purpose of performing a job, it is noted by the examiner that these broader definitions while different in fact for PC and WS overlap between PC and WS. Thus the examiner refers to the specification to determine if there is evidence of the breadth of the term PC intended by the original inventor.

In the specification the examiner finds a broader intended use of the term PC than that of an IBM PC running WINDOWS 386. The Inventor Klug states in the specification "Traditionally, a personal computer is defined as a single-user microcomputer designed for personally controllable applications" (page 9, lines 28-29). The specification continues, "However, recently introduced single-user computers have many times the processing power of their predecessors, and the term personal computer covers a wide variety of products. Today, single-user personally controllable "desktop" computers are used in technical or engineering workstations for CAD/CAM and the like. Many of these personal computers use reduced instruction set computing (RISC) microprocessors, and can perform functions in a single-user system, which were until only recently available just from mainframes. With the introduction of yet more powerful machines, the capabilities of personal computers will continue to evolve and expand" (page 9, lines 29-34 and page 10, lines 1-3). It seems to do this refers to something more powerful than the IBM PC running WINDOWS 386 fitting this definition of a PC. The specification further states that on top of the IBM PC considered referred to in the declaration as PC's, computer built using Motorola 86030 and 86040 processors and

(RISC) microprocessors are PC, notably these are used also by Sun, Hewitt-Packard and DEC computers (specification page 10, lines 4-19) these companies are also used in Nutt's second declaration as a part of the definition of a workstation (second declaration page 2, paragraph 8). Examiner is not saying one company could not make more than one class of computer but that with the multiple definitions the lines between PC's and workstations were not all that clear in 1989. Further the specification details that a multitasking operating system existed at the time for IBM PC, which was called OS/2, note a multitasking operating system was another definition of workstations (second declaration page 2, paragraph 8). It is also noted that for the invention the specification requires that at least one PC have the ability of multi-tasking, (page 11, lines 5-13) if a multi-tasking PC is unavailable in 1989 as the declaration seems to indicate in its arguments against obviousness over the art of record the specification would be non-enabling as it requires an existing multitasking PC as an integral component of the invention (page 11, lines 5-13). However as OS/2 did exist for use on PC's and was known to those of ordinary skill in the art at the time of the invention, the specification is enabling, and it also would have been obvious to use a PC in the system described by Sarin and it would have multitasking through OS/2 thus resulting in a personal computer to provide an update for a file to two or more user devices substantially contemporaneously with the execution of an edit for the file. Machines with the IBM PC architecture running WINDOWS 386 may have been the most common PC on the market in 1989, however, the test for obviousness is not what is most common but what is known to be available and more powerful PC's

with more sophisticated operating systems where known to be available. Thus the art is modified to address the amendment as follows.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-3, 6-16, 19, 22-24, 30 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Sarin et al in “Computer-based Real Time Conferencing Systems” as part of a text by edited by Grief in Computer-supported Cooperative Work: A Book of Readings. Note: the text and article were provided by applicant as part of an information disclosure statement.

8. As to claims 1, 12 and 13, Sarin describes two systems that were in public use in 1982 and 1984 during demonstrations at conferences (see page 398 last full paragraph) a data processing system comprising: “a processor” the one of the personal computers, “a plurality of ports” between personal computer processor its monitor and other subsystems and other personal computer along telephone lines, and “receiving an input...” editing the same design drawing with cursers visible to both users of allowing either user to edit a document, the fact real-time is

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specified shows that updates to displays are received “substantially contemporaneously with the execution of the edits.” It is also noted that user devices is a very broad with no definition or usage in the specification to draw on for meaning it can refer to terminals or computers or portions of a computer such as the monitor or display unit and the memory unit, as they are all devices and either used by user directly or at least holding or processing user data. Thus sending to two devices could include a display inherently used if edits visible to user as detailed in cite, and memory would be inherent as any data displayed is stored in some memory.

9. As to claims 3, 8, and 19, Sarin teaches a “communication network” or telephone line (see page 398 last full paragraph).

10. As to claims 9-11, 30, and 30, Sarin further teaches “graphics” and “text” (see page 398 last full paragraph) design drawings are thought to include “graphics” and “text”.

11. As to claims 15 and 16, Sarin teaches a system where it would be inherent that some portion of the application program and data be “obtained from data storage” as a workstation must have a copy of the commands it is executing and the data it is operating on to operate (see page 398 last full paragraph).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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13. Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarin et al in “Computer-based Real Time Conferencing Systems”.

14.

15. As to claims 1, 12 and 13, Sarin details a data processing system comprising: “a processor” (page 410, first full paragraph), “a plurality of ports” (page 411, figure 15.3(a) and 15.3 (b)), and “receiving an input...” (page 410, second full paragraph through page 412 last full paragraph) the fact real-time is specified shows that updates to displays are received “substantially contemporaneously with the execution of the edits.”

16. In his main embodiment Sarin described using computers that were more powerful than the personal computers of the time, Sarin also described systems that had successfully provided real time conferencing (page 398, last full paragraph) and talks about using personal computers connected by telephone lines (page 418 third full paragraph).

17. It would have been obvious to one of ordinary skill in the DP art at the time of the applicant's invention to combine the personal computers and with the system described by Sarin because Sarin suggested in and they are readily available and comparatively economical system reducing overall cost.

18. As to claims 2, 7 and 14, Sarin teaches a system further comprising: “a host computer” (page 410, first full paragraph) and “multi-task” (page 410, first full paragraph) a processor capable or being time-shared is capable of being multitasked.

19. As to claims 3, 8, and 19, Sarin teaches a “communication network” (page 410 first full paragraph and pages 416-417).

20. As to claims 4-5 and 20-21, Sarin et al. does not directly detail “analog networks” or “modems”. However Sarin describes a previous system which included telephone links between two PC’s and it is implicit that these phone lines are used through modems (see page 398 last full paragraph) further he suggests that under some situations it would be advantageous to implement systems such as he describes on personal computers communicating over a telephone line (page 418 third full paragraph). It would have been obvious to one of ordinary skill in the data processing art at the time of the applicant's invention to use analog networks and modems in Sarin system because doing so would allow lower cost more easily implemented interfaces to computers that are a location that is remote from the processor and any digital network it might be on system improving the versatility of the DP system.

21. As to claims 6 and 22-24, Sarin teaches “digital networks” (page 417, third full paragraph).

22. As to claims 9-11, 30, and 31, Sarin further teaches “graphics” and “text” (page 411, figure 15.3(a)).

23. As to claims 15 and 16, Sarin teaches a system where it would be inherent that some portion of the application program and data be “obtained from data storage” as a workstation must have a copy of the commands it is executing and the data it is operating on to operate (page 410, first full paragraph).

24. As to claims 17 and 18, Sarin et al. does not detail remote storage or non-persistent. The examiner understands non-persistent to refer to locally non-persistent or available locally only as needed, examiner finds no support in the specification to determine proper interpretation.

Remote memories are well known in the art. Storing the application program remotely could

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reduce memory usage in the local machine and reduce the number of copies needed for the system as the application would only be present in any particular local system as needed and be non-persistent locally.

25. As to claims 25- 29, Sarin does not detail a hub, switch, bridge, or gateway, but these are all common digital network devices for connecting digital networks or connecting computers to a digital network. It would be obvious to allow one or more of these devices because it would allow flexibility in connecting and adding to a digital network facilitating the addition of more user devices.

Conclusion

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Turley J. L. PCs Made Easy, page 111-122, Different Operating Systems.

DeBoever, L. R. Is OS-2 to OS-2 LAN Mgr. as MS-DOS is to UNIX?

Rosenberg, PH.D. Dictionary of Computers, Information Processing, and Telecommunications, 2nd Edition.

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

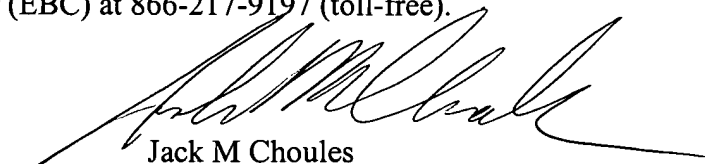
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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack M. Choules whose telephone number is (571) 272-4109. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jack M Choules
Primary Examiner
Art Unit 2167

5 May 2005